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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,971	01/15/1999	GABRIELE VALENTE	30966.13USWO	7959

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/214,971

Applicant(s)

VALENTE, GABRIELE

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-36 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 10-12, 15-17 and 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 13, 14, 18, 19, and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RESPONSE TO AMENDMENT

Request for Continued Examination

1. Due to the previous request for a continued prosecution application (CPA) filed November 13, 2000, this application is no longer eligible to request an additional CPA. *See Changes to Application Examination and Provisional Application Practice*, Interim Rule, 65 *Fed. Reg.* 14865 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (Apr. 11, 2000). The improper request for a continued prosecution application (CPA) filed December 24, 2002 was automatically treated as a request for continued examination under new 36 CFR 1.114.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 24, 2002 has been entered.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112 rejections of record in paper #17, pages 2-3, paragraph #5 have been withdrawn due to Applicant's amendment and/or arguments in paper #26.
4. The 35 U.S.C. §103 rejections of record in paper #15, pages 3-5, paragraphs #9 and #10 and paper #17, pages 3-9, paragraphs #6-15 have been withdrawn due to Applicant's amendment and/or arguments in paper #26.

NEW REJECTIONS

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

6. Claim 8 is objected to because of the following informalities: In line 3 the phrase “natural leather an embossed covering surface layer” should read “natural leather ***and*** an embossed covering surface layer”. The phrase “film in polyethylene” in line 3 should read “film ***of*** polyethylene.” Also, the phrase “suitcase elements spectacle-cases” in line 7 should read “suitcase elements ***and/or*** spectacle-cases”. Appropriate correction is required.

7. Claim 13 is objected to because of the following informalities: The phrase “suitcase elements spectacle-cases” in line 7 should read “suitcase elements ***and/or*** spectacle-cases”. Appropriate correction is required.

8. Claim 31 is objected to because of the following informalities: The phrase “film in polyethylene” in line 3 should read “film ***of*** polyethylene.” Also, the phrase “suitcase elements spectacle-cases” in line 7 should read “suitcase elements ***and/or*** spectacle-cases”. Appropriate correction is required.

9. Claim 32 is objected to because of the following informalities: The phrase “suitcase elements spectacle-cases” in line 7 should read “suitcase elements ***and/or*** spectacle-cases”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

10. Claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603).

Parker discloses a synthetic leather composite comprising only two layers (no foam between the supporting material and film and the supporting material being directly coupled to the film) a sheet of a mixture of a reconstructed leather (supporting material) and an optional coating layer (col. 1, lines 53-66 and col. 6, lines 31-45). Color may be added to the coating formulation in order to give the surface of the synthetic leather sheet a more pleasant appearance (col. 6, lines 31-45). The synthetic leather using reconstructed leather has the ability to retain good properties of natural leather (col. 1, lines 26-40).

Parker discloses the claimed composite except for the coating layer being an embossed polyethylene film.

Irion discloses a synthetic leather composite comprising a fibrous web and an embossed polyethylene film (col. 51-63). Polyethylene is a well recognized as a protective coating material. It is tough, extensible, and abrasive resistant, it has a high tear strength, it is odorless, tasteless, and non-toxic, it can be formed or shaped by thermal means without additives and has a low specific gravity so that a given thickness will cover a relatively large area per pound (col. 1, lines 11-21). Furthermore, because polyethylene may be easily and cheaply embossed and may be colored with pigments or dyes, the composite is good for manufacturing very inexpensive and sturdy artificial leathers, furniture and surfacing, luggage coverings and similar materials (col. 51-63).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to you the protective embossed polyethylene film of Irion as the optional coating in Parker because of the improved protective properties of Irion's embossed polyethylene film such as toughness, extensibility, abrasive resistance, high tear strength, and it can be formed or shaped by thermal means without additives.

The combination of Parker and Irion disclose all the limitations of the instant invention except the step of forming the material into a shape to produce one of the claimed products.

Holtzman discloses using a synthetic leather for use as luggage (suitcase elements) including the step of forming the material into a shape to produce the luggage. The steps of forming the luggage includes the step of cutting the composite materials to form the product. See the summary of the invention, col. 1, line 53 to col. 2, line 42.

Lockwood discloses using an artificial leather for use in as a shoe vamp including the step of forming the material into a shape to produce the shoe vamp. The steps of forming the shoe vamp includes the step of cutting the composite materials to form the product. See column 1, lines 11-28 and example 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the synthetic leather composite of Parker and Irion as the synthetic/artificial leather of Holtzman or Lockwood because of the good properties of Parker and Irion to have good properties of natural leather and have improved protective properties such as toughness, extensibility, abrasive resistance, and high tear strength.

The method of forming the product is not germane to the issue of patentability of the (product itself or) method of using the product. Further, when the prior art discloses a product

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which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations in claim 24 "including coal bonding the film layer, the film layer not being extruded directly onto the leather," claim 26 "including hot bonding the film layer, the film layer not being extruded directly onto the leather" and claim 27 "effecting the embossing on the film layer during the bonding" are methods of production and therefore does not determine the patentability of the product itself.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Shirota et al. (3,652,747).

The combination of Parker, Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for an adhesive between the film and the leather.

Shirota discloses a synthetic leather composite comprising a base cloth, a foam layer and a synthetic high molecular weight coating wherein the layers are bonded together using adhesive (col.1, lines 24-38 and col. 11, lines 48-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use adhesive as taught by Shirota to bond the layers of Parker and Irion because they are solving a similar problem, making synthetic leather by bonding multiply layers together to form a composite. One would be motivated to use adhesive between the layer of Parker and Irion's composite because the adhesive would insure a strong bond.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Nishimure et al. (3,958,057).

The combination of Parker, Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for a dye stuff layer between the film and the leather.

Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (col. 3, line 54 to col. 4, line 30). Where the colored layer is a dyestuff layer (col. 4, lines 5-14). The leather-like sheet material exhibits the ability to easily perform color matching (col. 2, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the reconstructed leather layer and the film layer of the combination of Parker and Irion. One would be motivated to do so in

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order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

13. Claims 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Hara (JP 404130172 A).

The combination of Parker, Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for adding a leather scent.

Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (Derwent abstract).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Parker and Irion. One would be motivated to add the leather perfume to the composite material of Parker and Irion in order to enhance the simulation of real leather.

14. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of ROHM SND HASS COMPANY (GB 1,514,224).

The combination of Parker, Irion and Holtzman or Lockwood disclose all the limitations of the instant claimed invention except for a series of perforations in the composite material.

Rohm discloses a composite material that simulates leather and may be used in virtually all areas where real leather can be used, for example, in upholstery, apparel, handbags, luggage

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and footwear (page 1, lines 23-27). The composite material comprising a fabric layer, a crushed foam layer, and a surface finish laminate layer (page 1, lines 28-36). The surface finish laminate can be embossed (page 5, line 36) and made of polyethylene (page 5, line 22). The film can be made breathable by mechanically puncturing (perforations) the film (page 5, lines 56-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add perforations as taught by Rohm to the composite of Parker and Irion. One of ordinary skill in the art would have been motivated to add perforation to the composite of Parker and Irion to increase the breathability of the composite.

ANSWERS TO APPLICANT'S ARGUMENTS

15. Applicant's arguments filed in paper #26 regarding the 35 U.S.C. §112 and §103 rejections previously of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

Alicia Chevalier

5/1/03

